

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Docket Number (Optional)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

3670-45

Application Number	Filed
10/092,535	March 8, 2002
First Named Inventor	STILLE
Art Unit	Examiner
2684	Aminzay, Shaima Q.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the
 Applicant/Inventor



Signature

Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

John R. Lastova

Attorney or agent of record 33,149
(Reg. No.)

Typed or printed name

703-816-4025

Requester's telephone number

Attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 C.F.R. § 1,34 _____

January 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

*Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

STILLE et al.

Atty. Ref.: 3670-45; Confirmation No. 8875

Appl. No. 10/092,535

TC/A.U. 2684

Filed: March 8, 2002

Examiner: Aminzay, Shaima Q.

For: METHOD AND DEVICE FOR A SHARED RADIO NETWORK

* * * * *

January 11, 2006

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final office action dated July 18, 2005, Applicants file this pre-appeal request. An interview was conducted with the Examiner on January 4, 2006 during which the undersigned explained the deficiencies of the pending rejection. The Examiner was not persuaded to withdraw the rejection.

Clear Error #1: Neither Purnadi Nor Chow Teach Multiple Owners Of The Same Network

The Examiner rejects all claims as being unpatentable over U.S. Patent 6,708,031 to Purnadi in view of U.S. Patent 6,456,839 to Chow. Purnadi describes a handoff procedure where the mobile terminal may visit another network other than its home network. Purnadi wants subscribers to be able to roam between cellular networks and preferably access the same services

available in the home network when they are visiting other networks. Purnadi fails to disclose any teaching that *one network is shared by multiple owners*.

Purnardi and Chow both describe visited networks in the context of roaming and handover. The Examiner apparently equates a mobile "visiting" a network other than its "home" network with shared ownership of a network. But they are not the same. Nor would a person of ordinary skill in cellular communications confuse these two very different concepts.¹

A visited network is visited from the mobile's perspective. A mobile has a home network to which it subscribes. In Purnadi, that home network is owned by a home network operator. When the mobile roams into another service area outside the service area of its home network, the mobile may obtain service as a roaming mobile from a visiting network, assuming the mobile's subscription permits the mobile to be serviced in that visiting network. But the home network operator does not own the visited network. Nor does the visited network operator have an ownership in the home network. The fact that the home network and the visited network have a roaming agreement that allows certain of the home network mobile's to receive roaming service from the visited network has no bearing on the ownership of those networks.

The Examiner seems to be arguing that the visited network is sharing its network with the visiting mobile terminal or with the home network operator. But a roaming agreement between two networks (the Examiner's argued sharing arrangement) is not all that is claimed. The independent claims specifically recite "determining which one of the *owners of a shared radio network* that a visiting MT (Mobile Terminal), which MT is not subscribed to any of the owners of said shared radio network, is going to be connected to." Neither reference teaches a shared

¹ Figure 2 illustrates an example of a network shared by multiple operators/owners. It is plain from this figure that a shared network ownership is different than roaming arrangements between network operators.

radio network having multiple owners. As a result, the decision as to which owner the mobile will be connected to that is required by the pending claims is not made in either Purnadi or Chow.

The Examiner never acknowledges this distinction between a visited network owned by one operator and a shared network serving a visiting mobile terminal that is owned by multiple operators. To highlight this difference, consider the example of a shared 3G network in the instant specification. 3G radio networks are expensive. One way to decrease the costs is for two or more 3G operators to jointly buy a shared 3G radio network like a UTRAN. But nothing in Purnadi discloses or suggests that the UTRAN 103 is shared by two or more network operators.

The Examiner was asked to identify where Purnadi discloses a single network *owned* and shared by two or more operators. That request remains outstanding. The Federal Circuit has clearly stated that the burden is on the Examiner to provide the factual basis for its rejection. See e.g., *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984). That burden has not been met in this case.

Clear Error #2: Neither Purnadi Nor Chow Teach Determining Which Owner The Mobile Terminal Is Going To Be Connected To

The Examiner admits that Purnadi does not disclose "determining *which one of said owners* said visiting MT is going to be connected based on the derived information," and relies on the Chow patent. Chow discloses a method for billing a neighborhood cordless service. A local cordless service provides a mobile wireless subscriber loop to allow a subscriber to disconnect their wired telephone service provided by their incumbent local exchange carrier. The local cordless service network defines a plurality of neighborhood zones, including a home

neighborhood zone and a visiting neighborhood zone from the perspective of the individual subscriber. Chow wants to permit the mobile subscriber, when roaming from one zone to another zone, to continue the call interrupted without paying air time charges. The same is true as the user moves into a cellular environment while participating in an active call.

The Examiner refers to column 16, lines 44 through column 17, line 6 of Chow, which simply describes a registration of a mobile station in a visiting network zone. Like Purnadi, Chow fails to disclose that the visited network referred to by the Examiner is *shared by different owners*. In the independent claims, it is not simply a matter of determining whether a mobile terminal is permitted to roam to a particular visiting network. Rather, the independent claims acknowledge that an *additional decision* is needed when a network is shared by two or more *owners*. Namely, it must be determined which one of the owners of the shared network that a visiting mobile terminal, which is not a subscriber with any of the owners of the shared radio network, is going to be connected to.

Neither Purnadi nor Chow teach this additional feature. So even if the combination of Purnadi and Chow could be made for purposes of argument only, that combination fails to disclose the features related to shared network owners.

Clear Error #3: There Is No Proper Motivation To Combine Purnadi and Chow

The combination of Purnadi and Chow is based on improper hindsight. To prevent the use of improper hindsight, the Federal Circuit requires the Examiner to show a motivation to combine the references. Specifically, the Federal Circuit has stated:

the Examiner must show reasons that the skilled artisan, confronted with **the same problems as the inventor** and with no knowledge of the claimed invention, would select the elements

STILLE et al.

Appl. No. 10/092,535

January 11, 2006

from the cited prior art references for combination in the manner claimed.

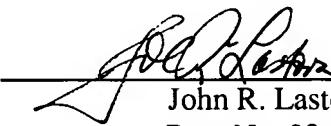
In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Neither Purnadi nor Chow acknowledge that a network owned by multiple network operators even exists, let alone the problems that confront the multiple owners/operators of such shared networks when a visiting mobile terminal, which is not a subscriber with any of the owners of the shared network, requires service from the shared network. The Examiner never addresses this deficiency notwithstanding the Federal Circuit's mandate above. Unlike Purnadi or Chow, the claimed invention solves these problems by deriving information from the visiting mobile terminal and using this information to determine which one of the owners of the shared network that the visiting mobile terminal is going to be connected to.

Lacking the combination of features recited in the independent claim and a proper motivation to combine the references, Applicants respectfully submit that the rejection should be withdrawn and this application allowed.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

John R. Lastova
Reg. No. 33,149

JRL:sd
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100